



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Baiju D. MANDALIA
Serial No.: 09/538,431
Group Art Unit: 2626
Filed: March 29, 2000
Examiner: Jerome GRANT II
For: METHOD AND SYSTEM FOR
CENTRALIZED INFORMATION
STORAGE RETRIEVAL AND
SEARCHING

CERTIFICATE OF MAILING

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ON: *March 18, 2005* BY: *Kara Longworth*

APPELLANTS' BRIEF UNDER 37 C.F.R. §1.192

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appellants' Brief is filed in response to a Final Office Action dated August 18, 2004, an Advisory Action dated December 28, 2004 and a Notice of Appeal filed January 24, 2005. Reconsideration of the Application, withdrawal of the rejections and allowance of the claims is respectfully requested.

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I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines (IBM) of Armonk, NY.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-18 are pending. Claims 1-18 were finally rejected in the Office Action dated August 18, 2004. In an Advisory Action dated December 28, 2004, the Examiner withdrew the rejection of claim 18 under 35 U.S.C §112 but maintained the rejection of claim 18 under 35 U.S.C §103(a). The Examiner's rejection of claims 1-17 is on appeal. Claim 18 depends from claim 17. Although the rejection of claim 17 is on appeal, the Examiner's separate rejection of claim 18 under U.S.C §103(a) is not being appealed.

Attached hereto is an Appendix containing a copy of claims 1-18 (in their current form), which are the claims involved in this appeal.

IV. STATUS OF AMENDMENTS

Appellants submitted a response with amendment on June 16, 2004 in response to a non-final office action. This amendment dated June 16, 2004 was entered. The Examiner issued a final rejection of claims 1-18 in the Office Action of August 18, 2004. Appellants submitted a response to this Final Office action, but this response did not contain amendments to the claims.

V. SUMMARY OF THE INVENTION

Preferred Embodiments of the present invention provide an improved system, computer readable medium, and apparatus for centrally managing documents in a client server system. The system includes database, a voice response system and a fax reception system to a telecommunications network. Specification, page 3, lines 20-23. The present invention provides a novel

combination of affordable scanning technology available through client fax machines, client telephone handsets, with web browsing to provide a centralized document storage and retrieval solution. Unlike prior art systems, the documents are loaded onto the centralized database storage using a fax machine and information which is associated with voice response. This combination makes it very easy for users to store fax images of documents in a database which is searchable by category and other user associated metadata. Specification, page 9, lines 3-15.

In using an exemplary embodiment of the present invention, a user through the voice response system, provides a login request over the telecommunications network using a fax machine with a telephone. The system checks to determine if the user has an account, and if the user does not have an account setting up an account with the user over the telecommunications network. Specification, page 3, lines 20—26. The operation of the present invention allows a user to enter an identifier for a document via voice recognition or other means. The user then uses his or her fax machine to fax a document to a database server. The database server then stores the received fax document into a database along with the user provided identifier. Specification, page 3, lines 26-29 and page 9, lines 3-15. To retrieve a document previously faxed for storage, the information relating to the document is searchable and the document can be faxed back to the user's fax machine. Specification, page 4, lines 1-2 and page 9, line 22 to page 10, line 1.

VI. ISSUE

Whether claims 1-17 are anticipated under 35 U.S.C. §102(e) by *Serbinis et al.*

VII. GROUPING OF CLAIMS

Group I: Claims 1-6, 9-11, and 13-15 stand or fall together.

Group II: Claim 7.

Group III: Claim 8.

Group IV: Claims 12, 16, 17 and 18 stand or fall together.

VIII. ARGUMENT

A. WHETHER CLAIMS 1-17 ARE ANTICIPATED BY *SERBINIS* ET AL.

In the Examiner's Office Action of August 18, 2004, the Examiner rejected claims 1-17 under 35 U.S.C. § 102(e) as being anticipated by *Serbinis* et al. (U. S. Patent No. 6,314,425) (Hereinafter *Serbinis*). The Appellants respectfully submit that claims 1-17 are not anticipated by *Serbinis* under 35 U.S.C. § 102(e). The Appellants respectfully assert that *Serbinis* does not teach the claimed limitations of: "receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in a database" and "receiving a fax reception" from "a user's fax machine" along with "storing the fax reception of the at least one document with the at least one identifier in the database." The *Serbinis* reference further does not teach or suggest: including "receiving telephone keypad entry for selecting a predefined category" as part of "receiving at least one identifier over the telephone system for a document." The *Serbinis* reference further does not teach or suggest: including "receiving a voice response for selecting a predefined category" as part of "receiving at least one identifier over the telephone system for a document. The *Serbinis* reference also does not teach or suggest: "using the voice response system, receiving a login request from a user over the telecommunications network using a client network unit" along with "using the voice response system prompting the user for a category to be associated with a document to be faxed from the user using a voice response."

Group I: Claims 1-4, 6, 1-10, and 14

Appellants respectfully suggest selection of independent claim 10 as representative of the Group I claims. Independent claim 10 is directed towards a

method for centrally managing documents in a client server system that comprises the steps of:

- coupling to a server system with a database to a telephone system;
- receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;
- receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received; and
- storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

To begin, the *Serbinis* reference is directed to an Internet-based document management system that allows electronic documents to be stored on an Internet-accessible server and accessed using a previously known web browser, downloaded for review or manipulation, and then returned to the server for access by further users. *Serbinis, Abstract*. The *Serbinis* reference describes an embodiment where personal computers are remote from a "Document Management Services" ("DMS") system. These personal computers host web browsers and are connected to the DMS system through a public standard telephone network ("PSTN") to an open network, such as the Internet. *Serbinis*, Column 5, lines 31-47. The *Serbinis* reference further teaches a security function that includes security information tables. *Serbinis*, Column 8, lines 4-11.

The Appellants respectfully assert that a proper rejection under 35 U.S.C. §102(e) requires that the *Serbinis* reference teach (i.e., identically describe) each and every element of the rejected claims that are anticipated by *Serbinis*.¹

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

The Appellants respectfully assert that the teachings of the *Serbinis* reference are limited to using a web browser on an Internet-connected personal computer to access, modify and store documents on an internet connected server. In contrast to the teachings of the *Serbinis* reference, the invention as claimed by the Group I claims includes:

receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;
receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received; and
storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

The Appellants respectfully assert that the only reference to facsimile communications in the *Serbinis* reference is limited to providing a notification that a document has been uploaded. See, *Serbinis*, Column 7, lines 59-65 and Column 19, lines 39-50. The Appellants respectfully submit that the *Serbinis* reference does not teach or suggest the use of a user's fax machine to transmit or receive the actual document being stored, as is recited for the group I claims.

The Appellants further respectfully submit that the *Serbinis* reference does not teach or suggest "receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database" as is set forth in the Group I claims. As a teaching of this limitation, the Examiner cites portion of the *Serbinis* reference that discusses document groups. Final Office Action dated August 18, 2004, page 3, first paragraph (*citing Serbinis*, column 7, line 27, column 8, lines 17-30 and item 61 of figure 2). The Appellants respectfully assert that the *Serbinis* reference never discusses "receiving at least one identifier ... for a document to be stored" as is set forth in the Group I claims. Furthermore, the *Serbinis* reference clearly lacks any teaching or suggestion of

receiving such an identifier “over the telephone system” as is also set forth in the Group I claims.

The Examiner’s apparent position regarding the teaching of a “fax machine,” as recited by the Group I claims, by the *Serbinis* reference is provided in the Advisory Action dated December 28, 2004, where the Examiner states:

While, *Serbinis* may not use a fax machine in the conventional sense, the generation of a document and the transmission of that document over a network, constitutes a fax transmission in the generic sense of facsimile.

Advisory Action dated December 28, 2004, page 3, first full paragraph. The Appellants respectfully disagree with the Examiner that generating a document on a computer, as taught by *Serbinis*, differs significantly from scanning a document on a fax machine. The Appellants therefore respectfully assert that the teachings of a computer generating a document cannot anticipate, under 35 U.S.C. §102(e), a fax machine.

The Appellants respectfully assert that the teachings of *Serbinis* do not encompass the use of a fax machine in a manner that is set forth and claimed by the Group I claims. The Appellants respectfully assert that “the generation of a document and the transmission of that document over a network” by Internet-connected personal computers that allow electronic documents to be stored on an Internet-accessible server and accessed using a previously known web browser, downloaded for review or manipulation, and then returned to the server for access by further users, is not a teaching of the use of a fax machine as claimed by the Group I claims.

The Examiner provides a detailed discussion for the rejection of claim 1, which is also a Group I claim and contains limitations similar to those of claim 10. The Examiner states: “*Serbinis teaches a method [...] from a user’s fax machine (col. 7, lines 58-65, teaches utilization of a system in an environment) in the database; receiving fax reception over the telephone system from at least one*

user's fax machine of at least one document corresponding to an identifier...". Final Office Action, dated August 18, 2004, pages 2-3. The Appellants respectfully disagree with the conclusion that the teachings of *Serbinis* related to a use of facsimile transmission can be extended or even properly applied to the Group I claims in any unpatentability analysis. The Appellants respectfully assert that a careful reading of *Serbinis* discloses a fax notification from the document management system, not a fax reception to the document management system, as is set forth in the Group I claims. Or in the words of *Serbinis* at col. 7, lines 59-65 (Emphasis Added):

Notification information tables 66 maintain information necessary to generate a notification message, and include entries for: notification transport type, i.e., e-mail, facsimile, voice, or pager; information on the status of the notification, i.e. pending, sent, failed; the recipient's notification identification; priority information; and optionally, the scheduled date/time for delivery.

The *Serbinis* reference goes on to describe the use of Fax machines as part of notification processing from the document management system to the user, as follows at column 19, lines 39-50 (Emphasis Added):

Notification Processes

Referring now to FIGS. 12A and 12B, the notification request and confirmation services available on a preferred embodiment of DMS system 17 are described. Notification messages are generated by notification server 35 in response to various user events. For example, when a registrant registers for a DMS service, the registrant receives a notification with instructions on authorization, as discussed hereinabove with respect to step 178 of FIG. 9.

As another example, when an Originator has created an electronic document and uploaded that document to the DMS system, Authorized Users having access to the document may receive a notification that the document is available to be retrieved (as discussed with reference to steps 108 and 114 of FIG. 5). In this case, the notification may contain instructions on how the document may be retrieved from the DMS system. The notification messages are digital and may take the form of an alphanumeric message, digital sound, digital image or other digital forms. DMS system 17 therefore preferably supports several types of notification transports including e-mail, fax, voice messaging and pager.

The above quotations contain the only reference to facsimile or fax machines contained in the entire *Serbinis* reference. Accordingly, the notification of users by fax from the DMS system as explicitly described by *Serbinis* is not the same as receiving a document to be stored by fax. *Serbinis* teaches that the previously created documents are uploaded and stored from a client system to the DMS system using a client system with client software such as a web browser or applet. See *Serbinis* at column 10, lines 20-23. In contrast in the present invention, the previously created documents are stored in the centralized database coupled to a server by "receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received." This receipt of the document by fax is patentably different over *Serbinis*.

The Appellants further respectfully disagree with the Examiner's statements at pages 10-11 of the Final Office Action dated August 18, 2004, which states (Emphasis Added):

At the top of page 14, Applicant argues that Serbinis is not applicable to the claimed feature for the reason that the notification of users by fax from the DMS is not the same as receiving a document to be stored by fax. While applicant's statement logically is true, namely that a notification of fax reception does not mean that there may be actual facsimile reception of a document. However, applicant's argument is not believed to be correct in view of Serbinis and by what is known in the prior art.

The Appellants respectfully submits that what *may be* possible is not the correct standard for a rejection 35 U.S.C. 102(e). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP §2112 (emphasis in original). The MPEP further notes that:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be

established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *Id.*, citing *In re Roberson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-54 (Fed. Cir. 1999)

The Appellants respectfully assert that since the *Serbinis* reference only teaches a system that uses Internet-connected personal computers and does not use fax machines to communicate documents to be stored, retrieved, etc., the use of a fax machine for these functions, as claimed by the Group I claims, cannot be inherent to the *Serbinis* reference.

Furthermore, the Appellants believe that the Examiner's statement regarding "*what is known in the prior art*" was unclear and ambiguous. Final Office Action dated August 18, 2004, page 10, first paragraph. The Appellants requested that if the Examiner had based statements on facts within the personal knowledge of the Examiner, that these facts be supported by filing an affidavit as is allowed under MPEP §707, citing 37 C.F.R. §1.104(d)(2). See, Response dated November 18, 2004, page 14, footnote 1. No such affidavit has been provided.

The Appellants respectfully assert that in order to properly anticipate the Group I claims, the *Serbinis* reference would have to teach or describe that its DMS system receives documents by using a user's fax machine. The Appellants respectfully assert that the *Serbinis* reference does not teach this aspect of the Group I claims. In contrast to the Group I claims, the *Serbinis* reference only teaches sending fax notification to a user when a document becomes available. See, *Serbinis*, column 19, lines 39-44. The Appellants respectfully assert that this is clearly not the same as storing documents with identifiers that were received from a user's fax machine.

At pages 10-11 of the Final Office Action dated August 18, 2004, the Examiner attempts to provide an analysis that connects the fax notification of

Serbinis to the claim limitations of the Group I claims by stating (Emphasis Added):

*At col. 7, lines 59-64, the administration table 64 maintains information necessary to generate a notification message and include entries for facsimile. For the management system to include an entry from a facsimile, it must be capable and operatively connected to a facsimile machine. At col. 7, lines 9-23, table 64 includes information regarding documents stored in memory 30. Col. 8, lines 48-57 refer to the actual document themselves. Because *Serbinis* suggest that present invention works in a facsimile environment it can be deduced that notification of a reception of a document is at least taught with respect to the management data tables 61-64*

The Appellants assume that the reference to the “present invention” in the above quotation is a reference to the system of *Serbinis*. The Appellants respectfully assert that it is an overstatement to characterize the *Serbinis* system as “operating in a facsimile environment” as a basis for extending the operation of the facsimile notification function of the *Serbinis* system to receipt of documents for storing in the database, as is set forth in the Group I claims. The teachings of *Serbinis* only peripherally use facsimile communications to notification a user that a document is available.

Furthermore, the Appellants respectfully assert that even the Examiner’s characterization of *Serbinis* is insufficient to anticipate, or even be applicable to, the Group I claims. As quoted above, the Examiner states that “it can be deduced that notification of a reception of a document is at least taught.” The Appellants respectfully assert that such a facsimile notification of a reception is the complete extent of the teachings of *Serbinis* with regards to facsimile transmissions. The Appellants further respectfully assert that such a teaching does not anticipate the processing of received facsimile data as is recited for the Group I claims.

Although the Examiner cites *Serbinis* as anticipating the Group I claims, the Appellants respectfully assert that the teachings of *Serbinis* that relate to

facsimile transmissions are not even able to be properly applied to the Group I claims in an obviousness analysis. For instance, the Appellants respectfully assert that the above analysis is based upon impermissible hindsight reconstruction of the invention set forth in the Group I claims. For example, the Examiner's assertion that "*for the management system to include an entry from a facsimile, it must be capable and operatively connected to a facsimile machine*" appears to force the structure of the claimed invention into some statements contained in the *Serbinis* reference. Further, even accepting, *arguendo*, the above quoted statement by the Examiner as true, the Appellants respectfully assert that it is not a relevant, let alone sufficiently complete, teaching of the limitations set forth in the Group I claims, which include receiving "at least one document" from "a user's fax machine" and "storing the fax reception of the at least one document with the at least one identifier in the database." The Appellants respectfully submit that this is not a teaching of reception by facsimile of a document for storage into the document database, as is set forth in the Group I claims. In contrast to the Group I claims, the *Serbinis* reference teaches the end-user using a web browser to upload the previously created document to the server not loading the server by receiving a fax transmission from a user's fax machine.

The Appellants respectfully assert that the Appellants' own specification is the only teaching or suggestion of "receiving a fax reception over the telephone system from at least one user's fax machine of at least one document" and then "storing the fax reception..." as is set forth in the Group I claims. Appellants respectfully assert that when there is no suggestion or teaching in the prior art, the suggestion can not come from the Appellants' own specification. As the Federal Circuit has repeatedly warned against using the Appellant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

In addition to the lack of a teaching, as discussed at length above, by *Serbinis* of “receiving a fax reception over the telephone system from at least one user’s fax machine of at least one document corresponding to the at least one identifier received” the Appellants respectfully assert that the *Serbinis* reference further has no teaching or suggestion of “receiving at least one identifier over the telephone system for a document to be stored from a user’s fax machine in the database.” The Appellants further respectfully assert that the only teaching or suggestion of this limitation is impermissibly provided by the Appellants’ own specification.

Although the Group 1 claims have been rejected as anticipated under 35 U.S.C. §102(e), the Appellants further respectfully assert that even under an obvious analysis under 35 U.S.C. §103, the modification of the fax notification of *Serbinis* to the fax reception processing recited for the Group I claims would lead to an inoperable system since the outbound notification system cannot receive faxes. If references taken in combination would produce a “seemingly inoperative device,” such references have been held to teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); *see also In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

The Appellants respectfully assert that since the *Serbinis* reference does not teach or suggest “receiving a fax reception” from “a user’s fax machine,” and the *Serbinis* reference further does not teach or suggest “storing the fax reception of the at least one document with the at least one identifier in the database” as is set forth in the Group I claims. The Appellants therefore respectfully request that the rejection of the Group I claims is improper and should be reversed.

Group II: Claim 7

Dependent claim 7 depends from independent claim 1 and is directed towards a method for centrally managing documents,

wherein in the step of receiving at least one identifier over the telephone system for a document includes receiving telephone keypad entry for selecting a predefined category.

The Appellants respectfully assert that the teachings of *Serbinis* do not include any reference to a “telephone keypad entry” as is set forth for the Group II claim.

As discussed above with respect to the Group I claims, the *Serbinis* reference does not include any teaching of “receiving at least one identifier” as is set forth in the Group II claim. The “at least one identifier” of claim 7 is defined in claim 1, from which claim 7 depends, as “at least one identifier over the telephone system for a document to be stored from a user’s fax machine in the database.” The Examiner cites a teaching of a personal computer (computer 10 and 11 of FIG. 1 of *Serbinis*). Office Action dated August 18, 2004, page 4, last paragraph.

The Appellants respectfully assert that the teaching of a personal computer is not a teaching of a “telephone keypad entry” as is recited for the Group II claim. The Appellants further assert that such a “telephone keypad entry” is also not inherent in a teaching of a personal computer. The Appellants also respectfully assert that even under an obviousness analysis, the teaching of a personal computer falls short of a teaching of a “telephone keypad entry.” Further, even if *Serbinis* did contain a teaching of a keypad, which the Appellants respectfully assert is not the case, the use of such a keypad to produce “a telephone keypad entry” that is included within “receiving at least one identifier” as defined by the Group II claim is certainly not taught or suggested by the

Serbinis reference. The Appellants therefore respectfully assert that this cited portion of the *Serbinis* reference is, at best, an incomplete teaching of the limitations of the Group II claim and that the *Serbinis* reference does not anticipate the Group II claims. The Appellants therefore respectfully request that the rejection of the Group II claims should be reversed.

Group III: Claim 8

Dependent claim 8 depends from independent claim 1 and is directed towards a method for centrally managing documents,

wherein in the step of receiving at least one identifier over the telephone system for a document includes receiving a voice response for selecting a predefined category.

The Appellants respectfully assert that the teachings of *Serbinis* do not include any reference to “*receiving a voice response for selecting a predefined category*” as is set forth for the Group III claim.

As discussed above with respect to the Group I claims, the *Serbinis* reference does not include any teaching of receiving an identifier. Although the *Serbinis* reference teaches storing documents in categories, the Appellants respectfully assert that the *Serbinis* reference does not explicitly teach receiving anything to select a predefined category. The Appellants further respectfully assert that to the extent that such an identifier would be inherent in the *Serbinis* reference, the *Serbinis* reference does not teach or suggest an identifier that is able to be verbally expressed by a human in order to constitute a “voice response” as is set forth for the Group III claim.

Further, the Examiner cites a portion of the *Serbinis* reference that teaches providing voice notification of documents that become available as an alternative to the facsimile notification discussed above with regards to the Group I claims.

As discussed above, the Appellants respectfully assert that the teaching of *Serbinis* of an outbound notification of the availability of a document is not a relevant, and especially not a sufficient teaching of “receiving a voice response for selecting a predefined category” as is set forth in the Group III claim.

In support of the rejection of claim 8, the Examiner characterized the cited portion of the *Serbinis* reference, which describes providing a voice notification to a user that a document is available, as a teaching that “voice activation is contemplated.” Final Office Action dated August 18, 2004, page 5, first paragraph, citing *Serbinis*, column 7, lines 60-62. The Appellants respectfully assert that “contemplation” of using a voice activation is not a proper standard for an anticipatory teaching under 35 U.S.C. §102(e) of “wherein in the step of receiving at least one identifier over the telephone system for a document includes receiving a voice response for selecting a predefined category” as is set forth in claim 8.² The Appellants therefore respectfully request that the rejection of the Group III claim under 35 U.S.C. §102(e) be reversed.

Group IV: Claim 12, 16, 17 and 18

Appellants respectfully suggest selection of independent claim 12 as representative of the Group IV claims. Independent claim 12 is directed towards a business method for centrally managing documents in a client server system that comprises the steps of:

² See MPEP §2131 (Emphasis Added) “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.”

coupling to a server system with a database, a voice response system and a fax reception system to a telecommunications network;
using the voice response system, receiving a login request from a user over the telecommunications network using a client network unit;
determining if the user has an account and if the user does not have an account setting up an account with the user over the telecommunications network;
using the voice response system prompting the user for a category to be associated with a document to be faxed from the user using a voice response; and
receiving a fax from the user of a document to be stored in the database that is associated with a category under an account for the user.

The Appellants respectfully submit that the Examiner is apparently extending the voice notification teachings of *Serbinis*, which are discussed above with regards to the Group III claim, into a teaching of the various uses of voice reception processing set forth in claim 12 for the Group IV claims. The Examiner is apparently basing anticipation of the voice response system recited for the Group IV claims on a "contemplation" of voice response by the *Serbinis* reference. See, Final Office Action dated August 18, 2004, page 5, first paragraph in combination with page 6, first paragraph. The Appellants respectfully submit that the voice notification teachings of *Serbinis*, which are limited to notifying a user that a document is available, are completely unrelated to the voice reception processing recited for claim 12.

The Appellants respectfully point out that claim 12 recites two limitations that specify "using the voice response system" for specific steps of the claimed business method. The first of these limitations recite "using the voice response system, receiving a login request from a user over the telecommunications network using a client network unit." The Appellants respectfully assert that this limitation, which uses a voice response system for "receiving a login request," cannot be anticipated by a teaching of providing a voice notification. The Appellants respectfully assert that the Examiner's own characterization of

Serbinis as only “contemplating” a voice response system falls far short of an anticipation of this claim limitation.

Further, the Appellants note that the *Serbinis* reference only teaches using voice notifications, which are obviously outbound messages to the user. Although the Examiner cites *Serbinis* as anticipating the Group IV claims under 35 U.S.C. 102(e), the Appellants respectfully assert that the voice related teachings of *Serbinis* cannot be properly applied in any unpatentability analysis of the Group IV claims, including even an obviousness analysis under 35 U.S.C. 103. The Appellants respectfully assert that the modification of the *Serbinis* reference to the invention claimed by the Group IV claims, which use the voice response system to receive a login request from a user, would yield an inoperable system. It is obvious that an outbound voice notification system cannot be successfully used to process received login requests from a user, as is recited for the Group IV claims. If references taken in combination would produce a “seemingly inoperative device,” such references have been held to teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

The second limitation that specifies “using the voice response system” recites: “using the voice response system prompting the user for a category to be associated with a document to be faxed from the user using a voice response.” The Appellants respectfully point out that the *Serbinis* reference does not describe prompting of a user for any input. Further, the use of any voice in the *Serbinis* reference is simply limited to providing voice notifications that a document is available.

The Appellants further respectfully assert that the voice response system recited for the Group IV claims far exceeds the capabilities of the simple voice notification of *Serbinis* that is cited by the Examiner. The capabilities of this voice response system are clear from the limitations contained within claim 12 itself that specify steps "using the voice response system" as discussed above. The specification further plainly describes the capabilities of this voice response system, which includes a voice recognition component and an interactive voice response system. The "interactive voice response" system is abbreviated in the specification as "IVR." Specification, page 5, line 20. The specification describes, for example: "the voice recognition component 114 and IVR component 116 both coupled to the database server 106 allows the user to navigate a menu of options for sending a document for storage, steps 402 and 404." Specification, page 8, lines 3-5. The Appellants respectfully assert that this voice response system, as specified in claim 12 with supporting description in the specification, far exceeds the simple voice notification of a document being available as described in the *Serbinis* reference.

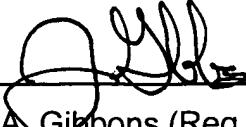
The Appellants respectfully assert that the differences between the simple voice notification system of *Serbinis* and voice response system specified in claim 12 clearly show that the teachings of *Serbinis* do not anticipate the Group IV claims. The Appellants therefore respectfully request that the rejection of the Group IV claims be reversed.

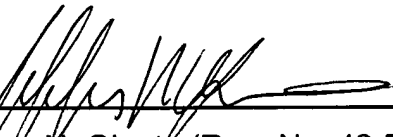
IX. CONCLUSION

For the reasons stated above, Appellants respectfully contend that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully submitted,

Dated: March 18, 2005

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X. APPENDIX

1. A method for centrally managing documents in a client server system comprising the steps of:

- coupling to a server system with a database, one or more client systems over a network;

- linking the server to a telephone system;

- receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

- receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received; and

- storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

2. A method for centrally managing documents according to claim 1, further comprising the steps of:

- receiving a search request for at least one identifier of at least one document from at least one of the one or more clients over the network;

- searching the database based upon the search request received; and

- presenting the results of the search of the database to the at least one of the one or more clients over the network.

3. A method for centrally managing documents according to claim 2, further comprising the steps of:

- receiving a selection from the at least one of the one or more clients over the network of the results presented;

- presenting an image of the document stored in the database over the network to the at least one of the one or more clients wherein the image corresponds to the selection of the results of the search.

4. A method for centrally managing documents according to claim 2, further comprising the steps of:

receiving a selection from the at least one of the one or more clients over the network of the results presented;

presenting an image of the document stored in the database over the network to the at least one of the one or more clients wherein the image corresponds to the selection of the results of the search.

5. A method for centrally managing documents according to claim 4, wherein the step of presenting an image includes presenting an image by sending the image to a fax machine that is under the control of a user of the at least one of the one or more clients.

6. A method for centrally managing documents according to claim 4, further comprising the step of:

receiving a security identifier from a user of the at least one or more of the clients;

and wherein the step of presenting an image includes presenting an image only if the security identifier received is matched with a security identifier previously associated with the document.

7. A method for centrally managing documents according to claim 1, wherein in the step of receiving at least one identifier over the telephone system for a document includes receiving telephone keypad entry for selecting a predefined category.

8. A method for centrally managing documents according to claim 1, wherein in the step of receiving at least one identifier over the telephone system for a document includes receiving a voice response for selecting a predefined category.

9. A method for centrally managing documents according to claim 1, wherein in the network is the Internet.

10. A method for centrally managing documents in a client server system comprising the steps of:

- coupling to a server system with a database to a telephone system;
- receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

- receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received; and

- storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

11. The method for centrally managing documents according to claim 8, further comprising the steps of:

- receiving a search request for at least one identifier of at least one document from at least one of the one or more clients over the telephone system;
- searching the database based upon the search request received; and
- presenting the results of the search of the database over the telephone system.

12. A business method for centrally managing documents in a client server system comprising the steps of:

coupling to a server system with a database, a voice response system and a fax reception system to a telecommunications network;

using the voice response system, receiving a login request from a user over the telecommunications network using a client network unit;

determining if the user has an account and if the user does not have an account setting up an account with the user over the telecommunications network;

using the voice response system prompting the user for a category to be associated with a document to be faxed from the user using a voice response; and

receiving a fax from the user of a document to be stored in the database that is associated with a category under an account for the user.

13. The business method for centrally managing documents according to claim 11, further comprising the steps of:

receiving a search request for at least one identifier of at least one document from the client network unit;

searching the database based upon the search request received; and

presenting the results of the search of the database over the telephone system to the client network unit.

14. A computer readable medium containing programming instructions for centrally managing documents in a client server system, the programming instructions comprising:

coupling to a server system with a database to a telephone system;

receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received; and

storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

15. The programming instructions of claim 14, further comprising the steps of:
receiving a search request for at least one identifier of at least one document from at least one of the one or more clients over the telephone system;
searching the database based upon the search request received; and
presenting the results of the search of the database over the telephone system.

16. A central fax storage and retrieval system for centrally managing documents over a telecommunications network:

- a server coupled to a telecommunications network;
- a fax receiver coupled to the server for receiving faxes sent from a user's fax machine;

- a telephone voice response system coupled to the server, the telephone response system having pre-recorded message prompts and voice recognition software for receiving user selections of the prerecorded message prompts, and the telephone response system receiving a message identifying a user; and

- a database coupled to the server, the database capable of storing electronically faxes received from the user's fax machine along with user information including user selections and user identification.

17. The system according to claim 16, further comprising:

- a voice recognition system for identifying a user by the voice message received.

18. The system according to claim 17, wherein the voice recognition system converts user voice messages received into user information using speech-to-text algorithms tuned to telephony.



Docket No. BOC9-1999-0056-US1

AFH
ZFW

In re application of: Bajiu D. MANDALIA

Serial No.: 09/538,431

Filed: March 29, 2000

For: METHOD AND SYSTEM FOR CENTRALIZED INFORMATION STORAGE RETRIEVAL AND SEARCHING

Mail Stop Appeal Brief- Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Transmitted herewith, in triplicate, is Appellant's Brief in support of its appeal to the Board of Patent Appeals and Interferences from the decision dated August 18, 2004 of the Examiner finally rejecting claims 1-18 of the above-referenced application.

- ☐ A petition for extension of time is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment in the amount of \$ 500.00 to cover the filing fee to Deposit Account No. 09-0452.
- ☒ The Commissioner is hereby authorized to charge payment of any necessary fees associated with this communication, or credit any overpayment, to Deposit Account No. 09-0452.

Respectfully submitted,

Date: March 18, 2005

By: 

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